

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Johannes Ruetschi)	
)	
Serial No.: 10/625,960)	Group Art Unit: 2626
)	
Filed: July 24, 2003)	Examiner: Justin W. RIDER
)	
Title: ANNOTATIONS ADDITION TO)	
DOCUMENTS RENDERED VIA TEXT-)	
TO-SPEECH CONVERSION OVER A)	
VOICE CONNECTION)	

Mail Stop **APPEAL BRIEF – PATENTS**
Commissioner for Patents
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REPLY BRIEF UNDER 37 CFR §41.41(a)

The Examiner's Answer (hereinafter "Answer"), mailed August 8, 2009, characterizes the appellant's response as a "key assertion ... that SPEILBERG fails to teach or even suggest, 'inserting a caller's speech annotations into an original message.'¹" Relying solely² on the Speilberg Abstract and Summary paragraphs 0018 and 19, the Answer asserts that it is "a misconception throughout appellants' arguments that there would appear to be some single 'master' file containing the original content along with a user's annotations presented in a way

¹ Answer (10) "Response to Argument," Page 11.

² "A prior art reference **must be considered in its entirety**, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (emphasis added, underline original); and see, MPEP §2141.02.

different from that of SPIELBERG. This point of view simply does not correspond to either the claims or specification as filed.³”

However, as Appellant previously noted, Spielberg specifically teaches that “there are **four** basic files associated with the annotation of a document as shown in FIG. 12⁴. These files comprise the **original document 1200** (i.e., the document to be annotated). The Annotations Names **File 1202**, the Annotations Index **File 1204**, and the Annotations **File 1206**.⁵” Furthermore, the “Document File 1200 comprises the document to be annotated and is **not typically modified during annotation**.⁶” After “the **comments are stored in the file structure** they may be **reconstructed upon request** by a user.⁷” Thus, Spielberg teaches storing multiple files during annotation and, leaving the original file 1200 pristine, reconstructing an annotated facsimile. This annotated facsimile is presented to the Spielberg user, while the original Spielberg file 1200 remains pristine.

By contrast, with reference to Figure 2⁸ of the application, if a “user decides to annotate the message at 220, the user ... [temporarily halts] the message delivery and to indicate the desire to annotate the rendered message.⁹” “The annotated speech is detected by the ASR at 240 and then gets **converted to text** using the Speech-to-Text conversion at 250.¹⁰”

When the caller completes the annotation, **the text** of the annotated speech (or the sound file) **is inserted in the original message** at 260. The present invention allows the annotated text to be inserted at the point where the message delivery stopped, at the beginning of the message or at the end of the message. In the exemplary embodiment, message rendering is resumed at 270 when the phrase

³ *Id.*, page 12.

⁴ Appeal Brief, Exhibit C.

⁵ Spielberg, paragraph 0095 (emphasis added).

⁶ *Id.*, paragraph 0096 (emphasis added).

⁷ *Id.*, paragraph 0103 (emphasis added).

⁸ Appeal Brief, Exhibit A.

⁹ Application, page 5, lines 9 – 12.

¹⁰ *Id.*, lines 24 – 15 (emphasis added).

"RESUME MESSAGE" or similar command predetermined by the individual user is detected.¹¹

So, once the text is inserted in the original message, playback resumes. Likewise, the claims recite and Spielberg fails to teach "inserting a caller's speech annotations into an original message."^{12,}

Thus, contrary to the Answer's conclusions, maintaining a single original "'master' file"¹³ is clearly supported by the application as filed and reflected in the original claims. Further, even if the written description had described generating and maintaining a separate annotation file from the converted text, which the application does not, that is not what is claimed. Instead, the claims recite and Spielberg fails to teach "inserting a caller's speech annotations into an original message."¹⁴ Thus, with regard to the misconception in the Answer that there does not "appear to be some single 'master' file containing the original content along with a user's annotations presented [in the present application] in a way different from that of SPIELBERG. This point of view simply does ... correspond to [both] the claims [and] specification as filed."^{15,}

Therefore, Spielberg fails to teach, and does not suggest, every element¹⁶ of claims 1 and 21. Neither does Spielberg teach or suggest "[t]he identical invention ... in as complete detail as is contained in"¹⁷ claims 1 and 21. Therefore the present invention as recited by claims 1 and 21 is not anticipated by Spielberg alone nor made obvious in combination with any other reference of record.

¹¹ *Id.*, line 30 – page 6, line 5 (emphasis added).

¹² Claims 1 and 21, lines 1 and 5.

¹³ *Supra.*

¹⁴ *Supra.*

¹⁵ *Supra.*

¹⁶ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

¹⁷ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Moreover the claims also specifically recite “storing said annotated message at a Unified Messaging server after inserting said speech annotation into said message.”¹⁸ This also is described in the specification in that “[w]hen the caller completes rendering the message, the caller may be asked (preferably using IVR system) to decide if the annotated (edited) message is to be saved as a new message or to **replace the original message**.”¹⁹ This is neither shown nor suggested by Spielberg. Therefore, Spielberg also fails to teach, and does not suggest, the present invention as recited in claims 18 and 38; and, the present invention, as recited by claims 18 and 38, is not anticipated nor made obvious by Spielberg alone, or in combination with any other reference of record.

Furthermore, since dependent claims include all of the differences with the references, as the claims from which they depend²⁰; Spielberg fails to teach, and does not suggest, the present invention as recited by claims 2, 5, 7 – 10, 12 – 17, 22, 25, 27 – 30, and 32 – 37, which depend from claims 1 and 21. The Appellants respectfully request reversal of the final rejection of claims 1, 2, 5, 7 – 10, 12 – 18, 21, 22, 25, 27 – 30, and 32 – 38 under 35 U.S.C. §102(e).

With regard to claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40, neither does either of Pizano et al. (cited²¹ to teach an original message containing an attachment) teach or suggest what is missing from, or overcome the above shortfalls of, Spielberg. Therefore, the combination of Pizano et al. with Spielberg fails to teach, result in, or make obvious the present invention as recited in claims 1 and 21, from which claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40 depend. The Appellants respectfully request reversal of the final rejection of claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40 under 35 U.S.C. §103(a).

With regard to the obviousness rejection of claims 19, 41, and 39, 42, which depend from claims 18 and 38, respectively; first one must combine the information contained in the four (4)

¹⁸ Claims 18 and 38.

¹⁹ *Id.*, lines 8 – 10 (emphasis added).

²⁰ *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

²¹ Final, page 7, #6.

Spielberg annotation files 1202, 1204, 1206 and original document 1200²², which is not taught or suggested by Spielberg. Moreover, even though Spielberg may not include claims specifically directed to this data structure, the data structure is inherently reflected in the Spielberg claims²³. Therefore, maintaining these four (4) Spielberg annotation files 1202, 1204, 1206 and original document 1200²⁴, are a Spielberg principle of operation. Certainly Spielberg does not teach or suggest overwriting the pristine original document 1200. Neither is there anything in Fuller et al. (cited²⁵ to teach querying whether to overwrite or save as new) teach or suggest modifying Spielberg to overcome this shortfall of Spielberg.

Therefore, “storing said annotated message includes creating a new copy of said message, said new copy including said original message and inserted annotations²⁶,” requires changing a principle of operation of Spielberg; and modifying Spielberg by changing a principle of operation is “[in]sufficient to render the claims [19, 39, 41 and 42] *prima facie* obvious.”²⁷ Accordingly, the Appellants respectfully request reversal of the final rejection of claims 19, 39, 41 and 42 under 35 U.S.C. §103(a).

Therefore, Spielberg does not teach the present invention; because there does “appear to be some single ‘master’ file containing the original content along with a user’s annotations presented [in the present application] in a way different from that of SPIELBERG. This point of view simply does ... correspond to [both] the claims [and] specification as filed.”²⁸ Neither does or Pizano et al. add what is missing from Spielberg. Therefore, the present invention, as recited in claims 1 – 17 and 20 – 37 is quite different than, and not suggested by, Spielberg alone or in

²² *Supra*.

²³ See, e.g., Spielberg claim 32, which recites obtaining two separate files, the original document and an annotation file; converting both the original document to speech; associating audio annotations to the original document for playback; and collecting additional comments.

²⁴ *Supra*.

²⁵ Final, page 10, #8.

²⁶ Claims 19 and 39.

²⁷ *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

²⁸ *Supra*.

combination with Pizano et al. Further, because Spielberg teaches, and more or less claims, generating additional annotation files 1202, 1204, 1206 for the original document 1200²⁹ as a principal of operation, “storing said annotated message includes creating a new copy of said message, said new copy including said original message and inserted annotations³⁰” requires changing a principle of operation of Spielberg. Therefore, modifying Spielberg to result in the present invention is not obvious; and Spielberg is not “sufficient to render the claims [18, 19, 38, 41 and 42] *prima facie* obvious.”³¹ Accordingly, the appellants respectfully request that the board reverse of the final rejection of claims 1 – 42 under 35 U.S.C. §§102(e) and 103(a) over Spielberg, alone or further in combination with Fuller or Pizano et al., and pass the application to issue.

The Commissioner is authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 50-3818.

Respectfully submitted,

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²⁹ *Supra.*

³⁰ Claims 19 and 39.

³¹ *Supra.*